



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER, EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

COPY MAILED

FEB 03 2005

OFFICE OF PETITIONS

In re Application of :
Claude F. Meares et al :
Application No. 10/631,258 : DECISION DISMISSING PETITION
Filed: July 31, 2003 : UNDER 37 CFR 1.181
Attorney Docket No. 023070-130920US :

This is a decision on the petition filed November 15, 2004, which is being treated as a petition under 37 CFR 1.181 requesting a corrected filing receipt which includes a list of prior-filed Application Nos. 10/625,047 and 10/350,555.

The petition is dismissed.

ISSUE

Petitioner states that the filing receipts mailed on November 17, 2003 and October 22, 2004 "do not list the priority applications of which the above-identified U.S. patent application claim [sic, claims] the benefit of." More specifically, petitioner states that on page 1, lines 3-8 of the "Cross-References to Related Applications" section of the instant application, the claim for priority reads as follows:

This application is a continuation-in-part of U.S. Patent Application No. _____, filed July 22, 2003 (Attorney Docket No. 023070-130910US, Multi-Functional Antibodies) which is a continuation-in-part of U.S. Patent Application No. 10/350,555, filed January 23, 2003, the disclosures of which are herein incorporated by reference in their entirety for all purposes.

Petitioner explains that a blank line was placed in the claim for priority because the application number for the continuation-in-part application; namely, Application No. 10/625,047, had not yet been assigned and that it was the intention to replace the blank line with the new application number once it had been assigned. Petitioner also points out that the filing receipts also failed to list Application No. 10/350,555, which also appears in the specification as filed.

Therefore, petitioner is requesting issuance of a corrected filing receipt in view of the inclusion of the priority information in the specification.

DISCUSSION AND ANALYSIS OF PETITION UNDER 37 CFR 1.181

Issuance of a corrected filing receipt would not be appropriate at this time since the claim for priority did not include the application number. While it is appreciated that petitioner did not have the application number of the prior-filed application on filing of the instant application, the rule nevertheless requires that the claim for priority identify both the application number, series code, and the relationship (which was stated) within four months from the filing date of the application or within sixteen months from the earliest filing date claimed. See 37 CFR §§ 1.78(a)(2)(i) and (ii). Petitioner's attention is directed to 35 U.S.C. § 120, which states, in pertinent part:

No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment **containing the specific reference** to the earlier filed application is submitted **at such time** during the pendency of the application **as required by the Director** [emphasis supplied].

MPEP 201.11 A. *Reference to Prior Nonprovisional Applications*, states, in pertinent part:

Any benefit claim that does not both identify a prior application by its application number and specify a relationship between the applications will not be considered to contain a specific reference to a prior application as required by 35 U.S.C. 120. Such benefit claim may not be recognized by the Office and may not be included on the filing receipt even if the claim appears in the first sentence of the specification or an application data sheet ***.

MPEP 201.11 also states, in pertinent part:

Except for benefit claims to the prior application in a continued prosecution application (CPA), benefit claims under 35 U.S.C. 120, 121 and 365(c) **must identify the prior application by application number** or by international application number and international filing date, and indicate the relationship between the applications [emphasis supplied].

Further, while a claim for priority to prior-filed Application No. 10/350,555 was present on filing of the instant application, this claim could not be entered in view of the absence of the application number of the prior-filed application from which benefit is claimed.

In view of the above, petitioner has not complied with the requirements of 35 U.S.C. § 120 and 37 CFR §§ 1.78(a)(i) and (ii). Accordingly, issuance of a corrected filing receipt is inappropriate at this time and the petition therefor must be dismissed.

However, petitioner does have a remedy by way of a petition under 37 CFR 1.78(a)(3) for obtaining the desired benefit under 35 U.S.C. § 120 to the prior-filed applications. A petition under 37 CFR § 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR § 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR § 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional where there is a question whether the delay was unintentional.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450

By hand: Customer Service Window
 Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

By fax: (703) 872-9306
 ATTN: Office of Petitions

Any questions concerning this matter may be directed to the undersigned at (571) 272-3218.

A handwritten signature in cursive script that reads "Frances Hicks".

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy